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| 09/600,832      | 07/21/2000  | ANDREAS GIEFER       | 67526               | 2069             |

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| EXAMINER |
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LUONG, VINH

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| ART UNIT | PAPER NUMBER |
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3682

DATE MAILED: 03/11/2002

#9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/600,832

Applicant(s)

GIEFER

Examiner

Luong

Art Unit

3682



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12/26/01.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 18-33 and 35-38 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-33 and 35-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/21/00 is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on 12/26/01 is: a) ☐ approved b) ☒ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some\* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Vinh T. Luong  
Primary Examiner

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 8
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☒ Other: *Exhibit*

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1. Applicant's Amendment filed on December 26, 2001 has been entered.
2. The proposed drawing correction filed on December 26, 2001 has been partially approved. The proposed drawing correction in Fig. 5 has been approved. However, the proposed drawing correction in Figs. 3, 4, and 7 has been disapproved because:

(A) the showing of the elastic portion 12 as now shown in Fig. 3 introduces new matter. The original disclosure does not describe, e.g., the size, shape and location of the elastic portion. The elastic portion may be, e.g., square instead of rectangular as now shown. The showing of a specific size, shape, and location of the elastic portion within a full spectrum of possible sizes, shapes and locations is considered under the present disclosure to be new matter. *Cf., In re Smith*, 173 U.S.P.Q. 679 (CCPA 1972) and *Ex parte George*, 230 U.S.P.Q. 575, 578 (Bd. Pat. App. & Inter. 1986);

(B) the proposed correction in Fig. 3 is inconsistent with the specification. For example, the amended paragraph starting on page 9, line 17, and ending on page 10 at line 5 describes the bracket 15, nevertheless, Fig. 3 shows that the element 15 is an axis of the roller 4.1 - 4.4;

(C) the proposed correction in Fig. 4 is inconsistent with the other figures. For example, Fig. 4 shows the selector lever 8 in the form of a straight line, meanwhile, Fig. 6 shows the selector lever 8 in the form of a cylinder;

(D) the showing of the signal receiver 14 (Hall sensors) and/or permanent magnets

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13 in Fig. 4 introduces new matter. The original disclosure does not specifically describe, e.g., the size, shape and location of the signal receiver and/or permanent magnets. The magnets may be located, e.g., at the center 3.1 instead at the periphery of the deflecting element 3.5 as now shown. The showing of a specific size, shape, and location of the receiver and/or magnets within a full spectrum of possible sizes, shapes and locations is considered under the present disclosure to be new matter. *Cf., In re Smith and Ex parte George, supra;*

(E) the proposed correction in Fig. 4 is inconsistent with the claims, e.g., claims 32 and 33 call for "signal receivers" (plural, emphasis), but, Fig. 4 shows only one receiver 14;

(F) the original claim 15 and the new paragraph between lines 12 and 13 on page 10 of the specification describe that the receivers are arranged at spaced locations from the signal transmitter, however, corrected Fig. 4 shows that the receiver 14 is in direct contact or engaged with the transmitters 13. The concept that the receiver 14 is in direct contact or engaged with the transmitters 13 is not conveyed in the original disclosure, i.e., new matter. *In re Anderson*, 176 U.S.P.Q. 331 (CCPA 1973); and

(G) the showing of the new element 16 in Fig. 7 introduces new matter. The original and/or amended specification do(es) not describe, e.g., the size, shape and location of the element 16. It is unclear what element 16 is since it is not described in the specification.

3. The drawings are objected to under 37 CFR 1.84 because:

(A) the drawings should show the plane upon which a sectional view such as Fig. 4 is taken; and

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(B) each part of the invention, such as, (1) the kinematics in claim 18; (2) the elastic louver portion in claim 27; (3) the signal transmitters and receivers in claims 32 and 35; (4) the permanent magnets and Hall sensors in claim 33; (5) the two deflecting axes in the amended paragraph starting on page 6 at line 18 and ending on page 7 at line 15 of the specification; (6) the fitting hole in line 7 on page 9 of the substitute specification; and (7) the first and second directions in claims 36-38 should be designated by a referential numeral or character.

Correction is required.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed features such as: (1) the kinematics in claim 18; (2) the elastic louver portion in claim 27; (3) the signal transmitters and receivers in claims 32 and 35; and (4) the permanent magnets and Hall sensors in claim 33 must be shown or the features canceled from the claims. *No new matter should be entered.*

5. The disclosure is objected to because of the following informalities: each part of the invention, such as, the kinematics in claim 18, the two deflecting axes in the amended paragraph starting on page 6 at line 18 and ending on page 7 at line 15 of the specification, the fitting hole in line 7 on page 9 of the substitute specification, and the first and second directions in claims 36-38 should be designated by a referential numeral or character. Appropriate correction is required.

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter, such as, "a first direction" and "a second direction" in claim 36. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction is required.

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7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 18-33, 35 and 38 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant claims, *inter alia*, the following claimed features: (1) the kinematics in claim 18; (2) the elastic louver portion in claim 27; (3) the signal transmitters and receivers in claims 32 and 35; and (4) the permanent magnets and Hall sensors in claim 33. However, the drawings do not show these claimed features. It is unclear as to how applicant makes/uses the above unillustrated elements.

Claim 38 calls for a bracket. However, applicant's original drawings do not show the bracket. Further, *Merriam Webster's Collegiate Dictionary* defines the bracket as an overhanging member that projects from a structure (as a wall) and is usually design to support a vertical load or to strengthen an angle. The element 15 in the proposed drawing correction in Fig. 3 is an axis, not a bracket as commonly defined by dictionary above. It is unclear as to how applicant makes/uses the bracket that movably connected to the cover plate as claimed.

9. Claims 18-33 and 35-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear:

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(A) which structures define the claimed elements such as: (1) the kinematics in claim 18; (2) the elastic louver portion in claim 27; (3) the slide rails in claim 29; (4) the signal transmitters and receivers in claims 32 and 35; and (5) the permanent magnets and Hall sensors in claim 33. Applicant is respectfully urged to identify each claimed element with reference to the drawings;

(B) which structures define the claimed element "a louver guide" in claim 18. If the louver guide is the slide rails 11 as described in the amended paragraph starting on page 7 at line 16 and ending on page 8 at line 9 of the specification, the slide rails 11 do not have at least one deflecting element 3.1, 3.2, etc. Consequently, claims 19, 20, etc. may become inaccurate and misdescriptive. Applicant is respectfully urged to identify each claimed element with reference to the drawings;

(C) which directions define the first and second directions in claim 36. Applicant is respectfully urged to identify the claimed directions with reference to the drawings;

(D) whether the term that appears at least twice, such as, "a cover plate" in claims 18 and 31 refers to the same or different things. See M.P.E.P. 2173.05(o); and

(E) claims 37 and 38 are dependent on claim 36 or not. Applicant claims that claims 37 and 38 are in accordance with claim A, however, there is no claim A.

10. Claims 18-21, 24, 26-29, 31, 36, and 37, as best understood, are rejected under 35 U.S.C. 102(a) as being anticipated by Andronis (DE 197 28 548 A1 cited in the Search Report of applicant's PCT application).

Regarding claims 18 and 31, Figs. 4-7 of Andronis teaches a motor vehicle transmission shifting device slot cover, the shifting device having a selector lever 6, 16 and kinematics for

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transmitting the selection movements to a transmission and at least one shift gate (at 3 in Fig. 4, see Exhibit attached), the slot cover comprising:

a movable louver 3 which covers the at least one shift gate, said louver 3 having at least one opening (see Exhibit attached) for the passage of the selector lever 6, 16, said louver 3 being an endless band forming a closed loop (Fig. 4);

a louver guide 14, 15, 38-46 for guiding the movable louver 3;

a cover plate 2, said louver guide 14, 15, 38-46 being moveable (when the lever 6, 16 is moved) in relation to said cover plate 2 at right angles to the direction of movement of the louver 3 with respect to said louver guide 14, 15, 38-46.

Claim 18 and other claims below are anticipated by Andronis since Andronis teaches each positive claimed element including its functional statement. In fact, when the lever 6, 16 is displaced (moved) by a sideways movement, the guide 14, 15, 38-46 is inherently displaced or moved therewith in relation to the cover plate 2 at right angles to the direction of movement of the louver 3 in the same manner as applicant's lever 8 (see applicant's Figs. 6 and 7, and page 9 of applicant's substitute specification). On the one hand, a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art teaches all the structural limitations of the claims. *Ex parte Masham*, 2 U.S.P.Q.2d 1647 (BPAI 1987). In addition, it is well settled that the functional limitations of a claim may not be given patentable weight where those limitations are inherent in a prior art reference. *In re Schreiber*, 44 U.S.P.Q.2d 1429 (CAFC 1997). On the other hand, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed



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invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding claim 19, said louver guide 14, 15, 38-46 has at least one deflecting element 39-42.

Regarding claim 20, said at least one said deflecting element 39-42 has a curved deflecting surface.

Regarding claim 21, said at least one said deflecting element 39-42 is one of a pulley 39-42 having a deflecting axis and a deflecting shaft.

Regarding claim 24, said deflecting element 39-42 is arranged within said louver closed loop 3 (Fig. 4).

Regarding claim 26, said louver guide 14, 15, 38-46 includes a support structure 44, said deflecting element 39-42 being mounted elastically to said support structure 44.

Regarding claim 27, said louver 3 comprises an elastic louver portion (see the vertical portion in the Exhibit) having elastic properties, at least in the circumferential direction of the closed loop, said elastic louver portion being provided over at least a part of a length of said louver.

Regarding claim 28, said louver 3 comprises a plurality of parts (i.e., horizontal and vertical parts in Fig. 4 of the Exhibit).

Regarding claim 29, said louver guide 14, 15, 38-46 includes a support structure 44 with slide rails 45 (Fig. 6) arranged laterally and engaged by said louver 3 for guiding said louver 3.

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Regarding claim 36, Andronis teaches a shifting device slot cover comprising:

a louver guide 14, 15, 38-46;

a louver 3 movably connected to said louver guide 14, 15, 38-46 in a first direction (which is the first sideway direction of the pivotal movement/displacement of the lever 6 in Fig. 4), said louver 3 including an endless band 3 forming a closed loop, said louver defining a selector lever opening (see Exhibit);

a cover plate 2, said louver guide 14, 15, 38-46 being movably connected to said cover plate 2 in a second direction (which is the second sideway direction of the pivotal movement/displacement of the lever 6 in Fig. 4 as seen in Exhibit), said second direction being substantially perpendicular to said first direction.

Regarding claim 37, said first and second directions are in a plane substantially parallel to a plane of said cover plate 2 (see Exhibit).

11. Claim 35 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, first and second paragraphs, set forth in this Office action.

12. Claims 22, 23, 25, 30, 32, 33 and 38 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first and second paragraphs, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

13. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

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14. Applicant's arguments filed December 26, 2001 have been fully considered but they are not persuasive.

### **DRAWINGS**

The proposed drawing correction has been partially approved as set forth above. Further, the examiner agrees that the drawings show the parts in claim 28, the slide rails in claim 29, and two openings in claim 30. The drawing objections regarding claims 28-30 are withdrawn.

### **35 USC 112, FIRST PARAGRAPH**

Applicant contends, *inter alia*, that:

Applicant has amended Figure 4 to show that the selection lever 8 is connected to kinematics which is then connected to the transmission. Applicant notes that the kinematics between the selection lever and the transmission can take many different forms, such as shift linkages, "Bowden controls" cables or electronic shift-by-wire. Such kinematics are well known to a person of ordinary skill in the art of vehicle transmissions, and it is Applicant's position that such a person would need no further description of the kinematics to make and use the present invention.

The examiner respectfully submits that the Court has long emphasized that the purpose of the "written description" requirement is broader than merely explaining how to "make and use," the applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession *of the invention*. The invention is, for purposes of the "written description" inquiry, *whatever is now claimed*. *Vas-Cath Inc. v. Mahurkar*, 19 U.S.P.Q.2d 1111 (CAFC 1991).

Second, the CAFC in *Lockwood v. American Airlines Inc.*, 41 U.S.P.Q.2d 1961 (CAFC 1997) and *Martin v. Mayer*, 3 U.S.P.Q.2d 1333, 1337 (CAFC 1987) has emphasized that the issue is not

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whether one skilled in the art would have been able to make the claimed kinematics using knowledge of the art, but rather did applicant's application sufficiently describe the claimed kinematics. Section 112 does not require that the specification contains that which is known to those skilled in the art, but it does require specificity as to the claimed limitations. It is "*not* a question of whether one skilled in the art *might* be able to construct the patentee's device from the teachings of the disclosure . . . Rather, it is a question whether the application necessarily discloses that particular device." *Jepson v. Coleman*, 136 U.S.P.Q. 647, 649-50 (CCPA 1963)(emphasis in original).

In the instant case, applicant claims the kinematics transmitting the selection movement of the lever to the transmission and the shift gate. The Statute and Codes require applicant to describe and show what is claimed, i.e., the kinematics. However, the original drawings do not show the kinematics as claimed. On the one hand, applicant notes that the kinematics between the selection lever and the transmission can take many different well-known forms, such as shift linkages, "Bowden controls" cables or electronic shift-by-wire. However, applicant does not provide anecdotal evidence by, e.g., citation of patents, publications, etc. to support applicant's conclusion. It is well settled that an expert's opinion on the ultimate legal issue must be supported by some thing more than a conclusory statement. *In re Buchner*, 18 U.S.P.Q.2d 1331, 1332 (CAFC 1991). On the other hand, the proposed drawing correction shows the kinematics in the form of a block diagram. The instant block diagram does not sufficiently describe as to how the claimed lever is moved *as claimed*, and consequently, the louver guide is moved therewith in relation to the cover plate at right angles to the direction of movement of the louver with respect to the louver guide *as claimed*.

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The rejection under 35 USC 112, first paragraph, is maintained for the reasons set forth above.

### **ART REJECTION**

First, applicant asserts that the element 4 in Fig. 1 of Andronis is not a closed loop and Figs. 4-7 and Figs. 1-3 of Andronis show different embodiments.

The examiner agrees that the element 4 in Fig. 1 is not a closed loop. However, the element 3 in Figs. 4-7 is a closed loop.

Second, applicant finds no indication that elements 39-42 and 44 of Andronis in Fig. 4 is combinable with Fig. 1. The examiner respectfully submits that the rejection is based on 35 USC 102(a), not 35 USC 103. The argument about combination under 35 USC 103 is apparently immaterial. The examiner used the referential numeral 4 to indicate the louver in the previous Office action because Fig. 4 apparently does not have a referential numeral to indicate the louver, meanwhile, Fig. 1 has the referential numeral 4 for the louver. It is well known that the same referential numeral is ordinarily used to indicate the same thing in different embodiments. See 37 C.F.R. 1.84. In other words, since referential numeral 4 is used to designate the louver in Fig. 1, the louver in Fig. 4 should be also designated by numeral "4."

To obviate the confusion of referential numerals in Andronis, the Examiner respectfully submits the attached Exhibit wherein the rejection is based on the embodiment of Figs. 4-7 only. Claims 18-21, 24, 26-29, 31, 36, and 37, as best understood, are anticipated by Andronis because the lever 6 is displaced (pivoted) relative to the cover plate 2 in multiple directions within the shift gate.

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These multiple directions inherently include the claimed first and second perpendicular sideways directions as seen in the Exhibit. Therefore, the rejection based on Andronis is maintained.

With respect to Hilderbrand, the rejection based on Hilderbrand is withdrawn. Applicant's arguments about Hilderbrand are deemed to be moot.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Luong whose telephone number is (703) 308-3221. The examiner can normally be reached on Monday-Thursday from 8:30 AM EST to 7:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci, can be reached on (703) 308-3668. The fax phone number for this Group is (703) 305-7687. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Luong

March 7, 2002



Vinh T. Luong  
Primary Examiner

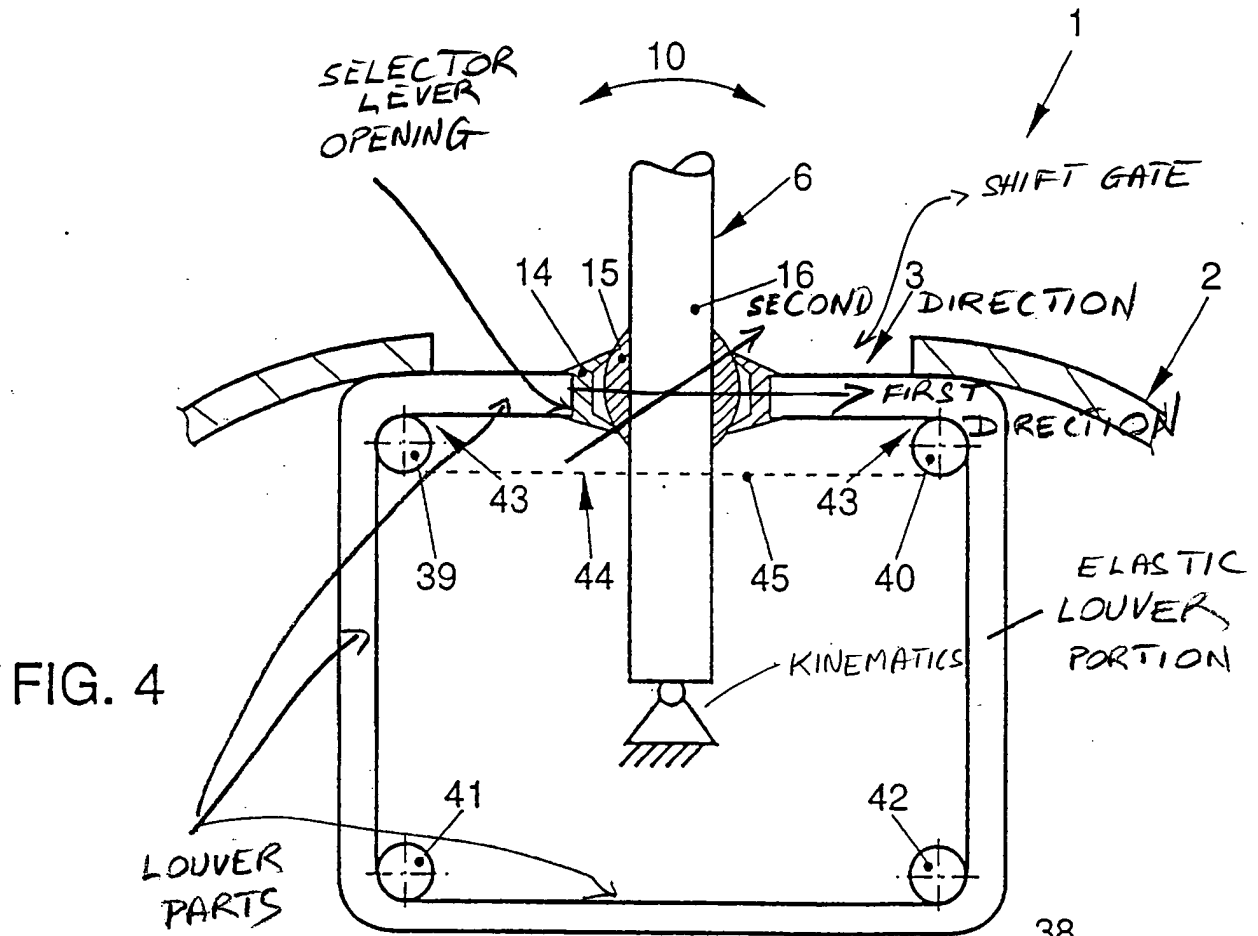


FIG. 5

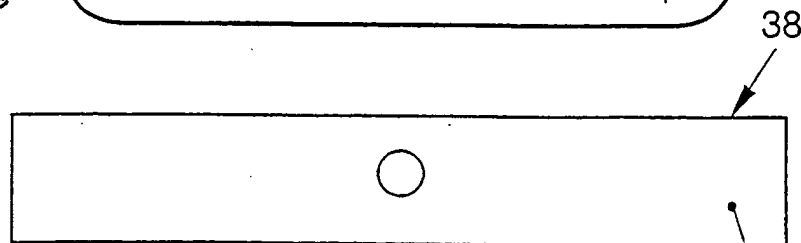


FIG. 6

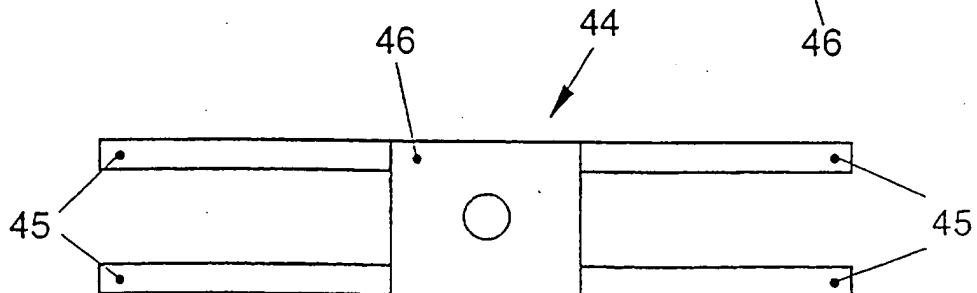
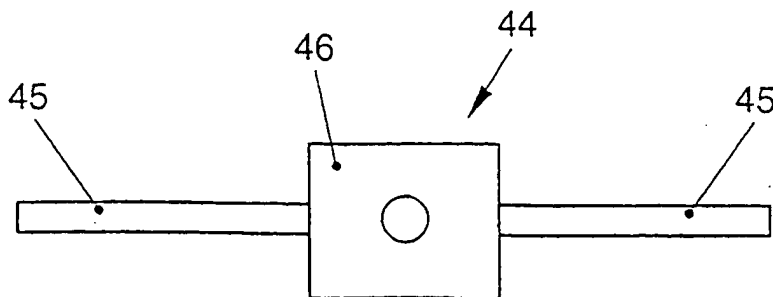


FIG. 7



EXHIBIT